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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,135

02/06/2004

Lukas Eisermann

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8402

46333

7590

10/06/2009

Medtronic

Attn: Noreen C. Johnson, IP Legal Department

2600 Sofamor Danek Drive

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

10/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,135	<b>Applicant(s)</b> EISERMANN ET AL.	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12 and 31-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/7/09(x3)</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments in the pre-brief conference request filed on 24 July 2009 are persuasive only insofar as they apply to the lack of an explicit teaching in the Marnay reference of an offset projection and/or recess. The statement in Marnay that it is advantageous that the receptacle and protrusion are in a central part (see, e.g., Marnay, col. 3, lines 13-16) does not rise to a teaching against those features being located somewhere away from the center if necessary--especially in light of the reference to Cauthen (6,019,792; of record) further discussed and applied below. While the rejection over Marnay alone is withdrawn, PROSECUTION IS HEREBY REOPENED in light of the following grounds of rejection.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing this action.

***Election/Restrictions***

Applicant's election without traverse of the invention of group I, in the reply filed on 06 January 2009, is acknowledged. Claims 37-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. As claims 11, 12 and 31-36 were previously withdrawn from consideration, claims 11, 12 and 31-39 stand withdrawn from consideration and claims 1-10 and 13-30 are under review.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 13-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnay (WO 01/01893; cited by Applicant) in view of Cauthen (6,019,792; cited by Applicant).

Marnay discloses the claimed invention including components 2, 3/4, flanges, e.g. 17, convex projection 25, and concave recess 12 (see, e.g., Figs. 1-3, 6 and 7). The components have a notch, e.g., 22, 23. The flanges comprise sharp portions, e.g., 7 and shearing edges of leading end. The flanges have through holes, e.g., 21. Marnay discloses the claimed invention except for explicitly teaching that the protrusion and recess can also be located somewhere other than a central location. Cauthen

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shows an articulating implant 10, and, like Marnay, teaches that the articulation means 40, 42 are “generally centrally located” on the articulation surfaces to align with the spine’s normal axis of rotation when implanted (see, col. 5, lines 63-67). However, Cauthen goes on to explicitly teach that the location “can be selectively varied to position the center of rotation of the articulation means centrally, anteriorly, posteriorly, to the left, to the right, or eccentrically (off-center in both anterior/posterior direction and the left/right direction) of the spine’s normal axis of rotation, in order to achieve proper alignment of the spine, thereby restoring optimal sagittal and coronal spinal balance and alignment.” (See, col. 5, line 67 - col. 6, line 7.) Given this teaching, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have located the projection and recess of Marnay offset from the center, in view of Cauthen, in order to achieve proper alignment of a misaligned spine, thereby restoring optimal sagittal and coronal spinal balance and alignment. Regarding the materials used, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have provided the device of the combination of Marnay and Cauthen with a bone growth promoting material to enhance fixation of the device to bone and to have formed the device of a cobalt-chrome-molybdenum metallic alloy for durability, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738